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Docket No.: 215900US90

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



RE: Application Serial No.: 09/986,005

Applicants: Naoto IKEGAWA, et al.

Filing Date: November 7, 2001

For: RESIN MOLDINGS

Group Art Unit: 1773

Examiner: Kruer, K. R.

SIR:

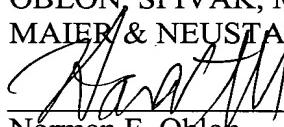
Attached hereto for filing are the following papers:

Petition under 37 C.F.R. § 1.181

Our check in the amount of _____ is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.


Norman F. Oblon

Registration No. 24,618

Customer Number

22850

(703) 413-3000 (phone)
(703) 413-2220 (fax)

Harris A. Pitlick
Registration No. 38,779

DOCKET NO: 215900US0



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

NAOTO IKEGAWA, ET AL.

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EXAMINER: KRUER, K. R.

SERIAL NO: 09/986,005

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FILED: NOVEMBER 7, 2001

: GROUP ART UNIT: 1773

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PETITION UNDER 37 C.F.R. § 1.181

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants respectfully petition the Commissioner from the refusal of the Examiner, as stated in the Advisory Action dated February 20, 2004, to withdraw the finality of the Final Office Action dated July 16, 2003 ("Final Office Action").

In their amendment "after Final" filed January 15, 2004, in response to the Final Office Action, Applicants traversed the finality thereof.

Applicants argued in said traversal, and continue to argue, that not all the new rejections were necessitated by amendment filed April 18, 2003. This is now demonstrated below.

Statement of facts

In the Office Action dated December 18, 2002 (Office Action), Claim 2 was rejected over two prior art grounds only, i.e., over U.S. 4,772,496 (Maeda et al), and over Applicants' admissions in view of U.S. 6,124,004 (Furuta et al).

In the amendment filed April 18, 2003, which was in response to the Office Action, Applicants amended Claim 1 by incorporating the subject matter of Claim 2 therein, and added new Claims 12-16.

In the Final Office Action, the Examiner rejected Claim 1 over a number of prior art grounds, including new grounds relying on U.S. 5,019,442 (Ogawa et al) under 35 U.S.C. § 102(b), and on U.S. 4,337,279 (Polak) combined with other newly-cited prior art under 35 U.S.C. § 103(a).

Argument

The Examiner was free to make new grounds of rejection of new Claims 12-16. However, amended Claim 1 was identical to original Claim 2 in terms of scope. In actual effect, Claim 2 was not amended since the subject matter of original Claim 2 was still being claimed in the guise of amended Claim 1. Thus, any new ground of rejection of amended Claim 1 was **not** necessitated by the amendment filed April 18, 2003. Therefore, the application for the first time of Ogawa et al, and of Polak combined with other newly-cited prior art, to reject Claim 1, was improper.

As set forth in MPEP 706.07(a), which reads in pertinent part:

[A] second or any subsequent action on the merits . . . will not be made final if it includes a rejection, on newly cited art, . . . **of any claim not amended** . . . in spite of the fact that other claims may have been amended to require newly cited art.

(Emphasis added.)

Thus, since the rejection of the subject matter of original Claim 2, and hence present Claim 1, on new prior art grounds, was not necessitated by the amendment filed April 18,

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2003, Applicants request that the finality of the Final Office Action be withdrawn, and the amendment "after Final" be entered as a matter of right.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Norman F. Oblon
Attorney of Record
Registration No. 24,618

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/03)
NFO/HAP/cja

Harris A. Pitlick
Registration No. 38,779